

Attorney Docket: 060258-0279296
Client Reference: 2980338US/Hm/kp



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: AHOLA et al. Confirmation Number: 2811

Application No.: 09/806,463 Group Art Unit: 2685

Filed: May 31, 2001 Examiner: Nguyen, Thuan T.

Title: METHOD OF DETERMINING HOME AREA FOR SUBSCRIBER TERMINAL, AN ASSOCIATED RADIO SYSTEM AND A SUBSCRIBER NETWORK ELEMENT

RESPONSE TO RESTRICTION REQUIREMENT

RECEIVED

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

JUN 23 2004

Technology Center 2600

Sir:

Responsive to the Restriction Requirement mailed May 19, 2004, the due date for response to which is June 21, 2004 due to the intervening weekend, the Applicants hereby elect for examination Group III (claims 9-10 and 15-16) with traverse.

For the following reasons, the Applicants respectfully submit that the Examiner's restriction requirement is improper.

I. Unity of Invention Practice, Not Restriction Practice, Is the Proper Standard to Be Applied to This Application

The present application is a national stage application submitted under 35 U.S.C. § 371. In particular, the present application is a national stage application of PCT/FI99/00813, filed October 1, 1999.

Accordingly, the Applicants respectfully point out that unity of invention practice, not restriction practice, is applicable here. As stated in MPEP §1893.03(d):

Examiners are reminded that *unity of invention (not restriction) practice is applicable* in international applications (both Chapter I and II) and *in national stage applications submitted under 35 U.S.C. 371*. Restriction practice continues to apply to U.S. national applications filed under 35 U.S.C. 111(a)

However, in the Restriction Requirement, the Examiner applied rules of restriction practice to attempt to justify restriction of the claims of the present application. For at least this reason, the Applicants respectfully submit that the restriction requirement is improper.

II. Under Unity of Invention Practice, the Claims of the Present Application Have Unity of Invention and Should Not Be Restricted

Moreover, if unity of invention practice is properly applied, the Applicants respectfully submit that the present claims have unity of invention and should not be subject to restriction.

As stated in MPEP § 1893.03(d):

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. *The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.*

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.

The Applicants respectfully submit that the claims sought to be restricted by the Examiner are indeed linked to form a single general inventive concept. The Group I claims (claims 1-7, 11-13, and 17-20) are respectively directed to a method for determining a home area for a subscriber terminal and a system adapted to carry out the method. The subscriber network element claims (Group II, claims 8 and 14) and subscriber terminal claims (Group III, claims 9-10 and 15-16) are respectively directed to components and apparatus that are adapted to carry out the method of the Group I claims, and that form a part of the system of the Group I claims.

Because claims 1-20 each define a solution in which a subscriber terminal transmits measurement results as a response to a command transmitted based upon predetermined

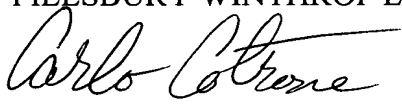
conditions, claims 1-20 include a common technical feature. Accordingly, the Applicants respectfully submit that claims 1-20 are linked to form a single general inventive concept with a technical relationship. As such, they share unity of invention and cannot be subject to restriction.

The Applicants also note that no objections as to unity of invention were raised during the international phase of the present application. This provides further support for the correctness of the Applicants' analysis herein.

III. Conclusion

For at least the foregoing reasons, the Applicants respectfully submit that the Restriction Requirement is improper. A first Official Action on the merits is respectfully requested. If further information is required, the Applicants request that the Examiner contact the Applicants' undersigned representative at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
PILLSBURY WINTHROP LLP

CARLO M. COTRONE
Reg. No. 48715
Tel. No. (703) 905-2041
Fax No. (703) 905-2500

Date: June 18, 2004
P.O. Box 10500
McLean, VA 22102
(703) 905-2000